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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/752,961 | 12/29/2000 | Catherine M. Duffy | LOT9-2000- 0027 US1 | 9956 |
| 27085 | 7590 | 09/23/2004 | EXAMINER | |
| IBM CORPORATION LOTUS SOFTWARE ONE ROGERS STREET CAMBRIDGE, MA 02142 | | | SCHLAIFER, JONATHAN D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2178 | |

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,961

Applicant(s)

DUFFY ET AL.

Examiner

Jonathan D. Schlaifer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 14, 18, 20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 14, 18, 20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/17/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is responsive to communications: Election filed on 7/6/2004.
2. Claims 13-14, 18, 20, and 22 are pending in the case. Claims 1-12, 15-17, 19, 21, and 23-25 have been withdrawn.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 14 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 6,748,425 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both discuss the use of a browser to access forms, and creating pages based on the forms. While claim 18 of '425 does not explicitly mention task name, start date, and priority fields, it would have been obvious to one of ordinary skill in the art at the time of the invention to use these fields in conjunction with claim 18 because claim 16, from which claim 18 descends, mentions workflow attributes and these are core workflow attributes.

Claim Objection

4. Claim 13 objected to because of the following informalities: On line 14, “approved” should be followed by “by”, and on line 16, “to” should be followed by “be”.

Appropriate correction is required.
5. Claim 20 objected to because of the following informalities: On line 7, “operating” should be “operate”. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 13-14 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention consists only of steps that could be performed by a person, and lack a technological basis.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 14 and 18 is rejected under 35 U.S.C. 102(e) as being anticipated by Vaughn et al. (USPN 6,353,446 B1—filing date 1/25/1999), hereinafter Vaughn.**
8. **Regarding independent claim 14, Vaughn discloses a method for creating pages in collaboration space (Abstract, lines 1-20, creates help pages in a network space), comprising the steps of: at a client browser providing a user interface to said collaboration space (col. 7, line 50—col. 8, line 10, a browser provides a user interface to**

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the help pages); responsive to a user request to create a new form displaying an add fields panel including a task field (task interactivity is described in col. 8, lines 10-30); responsive to user selection of said task field, providing input fields for said user to enter task name, start date, priority (these elements are present on Figure 25); thereafter, allowing users to create pages based on said form by selecting said form from a list of available form (the tabs for gauge/detail on Figure 8 allow this functionality).

9. Regarding independent claim 18, it is a system for carrying out the method of claim 14, and it is rejected under similar rationale.

10. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Amstein et al. (USPN 5,793,966—filing date 12/1/1995), hereinafter Amstein.

11. Regarding independent claim 20, Amstein discloses a program storage device readable by a machine (Abstract reveals a client/server system, inherently involving a storage device), tangibly embodying a program of instructions executable by a machine to perform method steps for creating forms in a place in collaboration space (col. 5, lines 15-55 disclose network creation of forms), said method steps comprising: creating at a browser a script file containing field properties and methods which display and operate on said field (col. 5, lines 15-55 disclose the use of Web scripting to manipulate the form, see lines 40-50 especially), and generating forms with reference to said field properties and method while generating hypertext links on the fly (col. 5, lines 45-55, an HTML response document is generated).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 13 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ivanov (USPN 5,706,452—filing date 12/6/1995).

13. Regarding independent claim 13, Ivanov discloses a method for adapting collaborative space to reflect workflow (see Abstract, lines 1-10), comprising the step of: responsive to request by a client browser user at an interface to said collaboration space to use a form to create a page (see col. 7, lines 20-55; Lotus Notes as described fits this limitation), providing an options page including work flow options selectable by said user for specifying workflow options for pages created using said form (see col. 7, lines 20-55; Lotus Notes as described fits this limitation), said options including: editor, specifying that pages created by said user will only be published after being approved by an editor; (see col. 8, lines 25-67, for how editors are assigned to edit the document); approval cycle, specifying that each page is to be routed through a series of members of a place in place in a specific order (col. 8, lines 45-55, the document is reviewed in stages); multiple editors, specifying that pages created by an author can, once published, be further edited by any of the authors in a room in said space (col. 8, lines 30-45, the reviewers can edit in parallel. Ivanov fails to disclose no special workflow, specifying that pages may be published by said user; and simple submit, specifying that pages may be created and submitted by said user. However, these settings are defaults, it was notoriously well

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known in the art at the time of the invention that they would have been built into workflow programs as basic settings, to allow functionality without special collaboration. It would have been obvious to one of ordinary skill in the art at the time of the invention to use no special workflow and simple submit as defaults, to allow functionality without special collaboration.

14. **Regarding independent claim 22**, it is a program storage device with instructions to perform the method of claim 13.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 5,537,526 (filing date 11/12/1993)—Anderson et al.

USPN 6,177,932 (filing date 8/21/1998)—Galdes et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D. Schlaifer whose telephone number is (571) 272-4129. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS



STEPHEN S. HONG
PRIMARY EXAMINER